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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,773	01/13/2000	John D. Dreher	2870/220	7449
26646	7590	05/29/2008	EXAMINER	
KENYON & KENYON LLP			YU, GINA C	
ONE BROADWAY			ART UNIT	PAPER NUMBER
NEW YORK, NY 10004			1617	
		MAIL DATE		DELIVERY MODE
		05/29/2008		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/482,773	DREHER, JOHN D.	
	<b>Examiner</b>	<b>Art Unit</b>	
	GINA C. YU	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 December 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

Receipt is acknowledged of amendment filed on February 15, 2008. Claims 1-12 are pending. Claim rejections as indicated in the previous Office action dated May 11, 2007 are withdrawn and modified to address the amended claims.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-5, 7, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura (US 5,690,916) as further evidenced by Wrinkles and Wrinkle Treatments ([www.skin-care-reviews.com](http://www.skin-care-reviews.com)).**

Kimura discloses a foundation comprising 9.0 % by weight of blue interference pigment and iron oxides, 11.0 % by weight of titanium dioxide, and sericite, other non-interference inorganic pigments. See Example 13; instant claims 1-5, 7, 9, and 11.

The claimed method of covering wrinkles of the skin as recited is inherently practiced by using the prior art composition, since wrinkles and lines are natural event and lines and wrinkles may be visible as early as 20-25 years of age. See Wrinkles and wrinkle treatments, p. 4.

The Board stated on p. 6, "application of the makeup composition to the skin of a person 25 to 35 years of age and older is inherent application to skin of a person 25 to 35 years of age and older is inherent application to skin exhibiting lines and wrinkles". Although the new limitation now requires the method step as applying to "the skin exhibiting age-associated lines and wrinkles", the board has clearly indicated that

anytime the Kimura invention is applied to the skin of person 25 to 35 years of age and older, it is inherently applied to skin exhibiting age-associated line and wrinkles.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hineno (US 6207174 B1) in view of Kimura.**

Hineno teaches a composite powder composition comprising interference or reflective pigments which is effective in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3. Example 6 discloses a foundation comprising sericite, iron oxides, and 9.32 % by weight of composite powder. See instant claims 1-7. Although the reference does not explicitly mention that the wrinkle is age-associated wrinkle, it would have been obvious that the prior art composition comprising interference pigments and inorganic powder would effectively camouflage the skin defect (i.e. wrinkles) regardless of the cause.

While the exemplified formulations contain 5 % of red interference pigments, blue interference pigments are also taught in the specification, col. 13-14, Production Example (4), and in col. 5, Table 1. See instant claim 10.

As discussed above, Kimura teaches a foundation comprising 9 % blue interference pigment and iron oxides, 11.0 % by weight of titanium dioxide, and sericite, other non-interference inorganic pigments. See Example 13.

Given the teaching of Hineno that interference pigments used in cosmetics cover wrinkles on the skin, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the exemplified cosmetic formulations of Hineno by using blue interference in a foundation as motivated by Kimura because 1) Hineno also generally teaches blue interference pigments useful for the invention; and 2) Kimura illustrates an example of a foundation comprising blue interference pigments. The skilled artisan would have had a reasonable expectation of successfully enhancing wrinkle coverage effect on the skin by applying a cosmetic composition comprising blue interference pigments.

**Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hineno and Kimura as applied to claims 1-7 and 9-12 above, and further in view of Hurst (“Face Powders”, Poucher’s Perfumes, Cosmetics and Soaps, 1993).**

Hineno and Kimura, discussed above, fail to teach bismuth oxychloride.

Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment and now developed to provide an improved photosensitivity. See p. 117, 2<sup>nd</sup> full par. The reference further suggests that it is possible to formulate compositions using pearlescent pigments to provide “translucent luster, or frosted effect, to enhance the wearer’s natural complexion”. See p. 117, 5<sup>th</sup> full par.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the method of the combined references by adding bismuth oxychloride to the cosmetic composition comprising blue interference pigments,

as motivated by Hurst, because of an expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

***Response to Arguments***

Applicant's arguments filed on March 22, 2007 have been fully considered but they are not persuasive.

**Rejections of the claim under 35 USC § 102(b)**

Applicant asserts that a skilled artisan reading the Kimura reference "would immediately understand that the compositions were not said to reduce the appearance of lines and wrinkles associated with aging of the skin". The statement is somewhat misleading because the reference does not in any way teach that applying the prior art to the user' skin would be inoperative in reducing the appearance of aging skin as applicant seems to suggest. As Board has indicated in Decision, p. 6, "the ordinary artisan need not recognize the inherent characteristics or functioning of the prior art".

Citing Eibel Process Co. v. Minnesota & Ontario Paper Co., applicant also argues that the present rejection relies on a possibility and 'accidental occurrence' of applying the Kimura invention to age-wrinkled skin and thus does not amount to a support for a rejection based on anticipation by inherency. See 261 US 45, 66 (1923).

The Board has found this argument 'unconvincing' because age-wrinkles and lines are inevitable and do not occur by accident or merely probability.

Applicant argues that Perricone v. Medicis Pharm. Corp. is relevant to the present case, citing that the court found applying to a sunburn skin a prior art

antioxidant skin benefit agent a new use of the old product. See 77 USPQ2d 1321 (Fed Cir 2005).

However, sunburned skin is not an inevitable and unavoidable event as and therefore is not analogous to aging skin. The Perricone court in fact separately considered the issue of inherency of applying the same composition to “affected skin areas” which included the condition results from “the natural aging process” and affirmed the lower court’s anticipation rejection based on inherency. The court found that, because all skin ages and the application of the claim merely requires application of the composition to the affected skin area, using the same composition claimed by in the same manner naturally results in the same claimed skin benefits. Thus, the Perricone case in fact supports the present rejection that the prior art method of applying the Kimura composition to discolored skin inherently results in skin which all naturally ages.

Applicant also argues that the amended claim now requires the method step to the skin exhibiting the age-associated lines and wrinkles, which, applicant asserts, is not analogous to skin surfaces generally. However, both the Perricone court and the Board have found that all skin ages, and practicing the prior art method inherently anticipates the claimed invention.

Applicant asserts that age-wrinkled skin is “a clearly distinctive skin condition which develops over times as a result of many factors.” The factors include time; and age-associated wrinkles and lines are inevitable event as the Board has also recognized.

Applicant states, “the reference compositions clearly may be applied to the hyperpigmented skin of a child or a person of any age, whose skin does not yet exhibit age-associated lines and wrinkles which are conspicuous to others”. Examiner respectfully disagrees with applicant’s argument; there is no limitation in Kimura that the prior art is somehow intended for those users whose skin has not yet developed age-associated wrinkles and lines; nor are the prior art users limited to any specific age group or to a population with youthful skin only. Furthermore, the users of present invention include all people because all skin ages and encompasses the population who apply the Kimura composition to their hyperpigmented skin. Examiner asserts that the present anticipation rejection is consistent with the holdings of the Board and the Perricone court.

Applicant also asserts that absent any extrinsic evidence that all skin bears age-related wrinkles, any application of the prior art to wrinkled skin is accidental. Examiner respectfully disagrees; according to Wrinkle and Wrinkle Treatment reference, skin aging is not accidental and the application of the prior art to wrinkled skin cannot be deemed as a mere accidental occurrence.

Applicant’s remarks that “skin color” is not a claim limitation are rendered moot as examiner’s statements regarding the previous claim limitation have been withdrawn from the present rejections.

**Rejections of the claim under 35 USC § 103(a)**

Applicant asserts that the disclosure of a specific use of a specific type of interference pigment would not have rendered obvious to a general use of an

interference pigments in disguising flaws. Applicant asserts that only red pigments would be expected to be useful for camouflaging wrinkles, and that there is nothing in the reference which would suggest that anything other than substantially red reflectance property would demonstrate any efficacy for hiding wrinkles.

Examiner respectfully disagrees. As applicant has admitted in the argument, the use of red interference composite powder is for the primary purpose of improving skin color. Using red interference color appears to be a mere preference to match the particular intended make up, and there is no evidence that it is the red tone of the color which imparts the wrinkle covering effect.

Furthermore, applicant's claimed method is not limited to using only blue interference pigments and the composition of the instant invention is open to include pigments other than blue, including red interference pigments. Violet interference pigments, for example, would require combination of blue and red interference pigments.

Applicant asserts that there is no connection of blue with wrinkles in either reference. The argument is unpersuasive because the Hineno composition camouflages both hyperpigmentation and wrinkles due to the light interfering property of the pigments, which is also the active ingredient of Kimura. In view of the combined teachings of the references, examiner views that choosing the color of the interference pigments to design a cosmetic with hyperpigmented and wrinkle coverage effect is well within the skill of the art.

**Rejection of Claim 8 under 35 U.S.C. § 103 (a)**

Applicant asserts that the rejection is improper because the Hurst reference does not cure the alleged defects of the Hineno and Kimura as previously argued. Examiner respectfully disagrees as discussed above.

Applicant further argues that adding bismuth oxychloride to add luster to the composition of Hineno/Kimura would result in undesirably glossy or lustrous appearance and insufficiently natural-looking. Examiner respectfully disagrees, as it is up to the skilled artisan to determine what is the desired ... Applicant's argument that only certain appearance would be acceptable or desirable in cosmetic art seems as a limiting subjective view. Furthermore, the reference teaches that bismuth oxychloride is produced in various grades, and the references already provide the specific functionality of each pigments used in the present invention. It is unpersuasive that using those pigments according to the objective teachings well known in the art would be somehow undesirable when applicant has employed the same ingredients in the present invention.

Applicant argues that the using non-matte, non-spherical powders in 2-10 % in combination with the interference pigment and metal oxide results in a surprising result of wrinkle coverage from all angles. However, the argument is not commensurate with the scope of the claims because only claims 6 and 12 bear such limitation. Furthermore, since Hineno and Kimono already teaches a similar composition comprising a non-matt, inorganic particle in combination with interference pigments, applicant's claim here is viewed as a discovery of optimal weight amount of the inorganic particle rather than of an unexpected result.

***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/  
Primary Examiner, Art Unit 1617